UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

ED

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/485,904	03/22/00	AUDOUSSET M	05725.0545

EXAMINER	
EINSMANN, M	
ART UNIT	PAPER NUMBER
1751	11

IM52/0712

FINNEGAN HENDERSON FARABOW
GARRETT & DUNNER
1300 I STREET NW
WASHINGTON DC 20005

DATE MAILED: 07/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/485,904	Applicant(s) Audousset
	Examiner Margaret Einsmann	Art Unit 1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *May 7, 2001*.

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *16-40* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *16-40* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

Applicant's Remarks filed 5/7/01 have been fully considered. Applicant states that she has filed a copy of an Information Disclosure statement which was originally filed 2/18/2000. There is no such Information Disclosure Statement in this application. The references cited in the PCT have been provided with the national filing. However, there are additional references on the "copy" of the IDS included with this application which are not in the file.

The information disclosure statement filed 5/7/01 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

The information disclosure statement filed 5/7/01 fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 16-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terranova.

Terranova, WO 97/49378, teaches compositions for dyeing hair which contain at least one pyrazolo[1,5-a]pyrimidine compound as oxidation base, which pyrazolo[1,5-a]pyrimidines

encompass those as claimed, and wherein Terranova's preferred pyrazolo[1,5-a]pyrimidines include those as claimed, see page 3, line 7-page 4, line 19; and page 4, line 26-page 5, line 30. The pyrazolo[1,5-a]pyrimidines are present in the compositions in the claimed amounts, see page 8, lines 13-16. Terranova teaches and claims that the compositions may contain an additional oxidation base in the claimed amounts, wherein preferred oxidation bases include the claimed N,N-bis(β-hydroxyethyl)-p-phenylenediamine, see page 9, line 24-page 10, line 9; page 11, lines 7-10; and claims 7-8. Terranova teaches that the compositions may also contain a coupler in the claimed amounts in order to modify the shades or enrich the glints, wherein preferred couplers include both m-aminophenols and m-phenylenediamines as claimed, see page 11, line 12-page 12, line 3. Terranova teaches that it is known in the hair dyeing art to mix oxidation base and couplers in order to obtain a wide range of colors, see page 1, lines 13-30. Terranova teaches processes of dyeing hair with oxidants as claimed, and teaches that the compositions may be packaged in kits as claimed, see page 13, lines 12-17; page 13, line 28-page 14, line 2; and page 14, lines 21-28. Terranova exemplifies various compositions which contain a mixture of a pyrazolo[1,5-a]pyrimidine oxidation base and coupler as claimed, wherein each component is present is the claimed amounts, and is applied to hair in a dyeing process as claimed, see Application Examples 2-5, 11-14, 21, 24 and 27. Terranova does not exemplify a dyeing composition, process or kit as claimed, particularly which contains or uses the claimed second oxidation base.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a composition for dyeing hair which contains a pyrazolo[1,5-a]pyrimidine first oxidation base, the second oxidation base N,N-bis(β-hydroxyethyl)-p-phenylenediamine, and a m-aminophenol or m-phenylenediamine coupler as claimed, wherein each component is present in the claimed amounts in mediums as claimed, wherein the compositions are applied to hair with an oxidant in a dyeing process as claimed, and are stored in kits as claimed, because Terranova teaches such compositions, processes and kits as preferred embodiments of the patentee's invention. Particularly, it would have been obvious to those skilled in the art to add the claimed N,N-bis(β-hydroxyethyl)-p-phenylenediamine second oxidation base to Terranova's exemplified compositions and processes identified above, resulting in compositions and processes as claimed, because the patentee teaches that this claimed additional oxidation base may be added to the patentee's compositions, and because Terranova teaches that it is known and conventional in the hair dyeing art to mix different oxidation bases and couplers in order to obtain a wide variety of colors, absent a showing otherwise.

Response to Arguments

Applicant's arguments filed 5/7/2001 have been fully considered but they are not persuasive regarding the above rejection. Applicant argues that to establish a prima facie case of obviousness, the prior art must either teach or suggest all of the claim elements, must provide some suggestion or motivation to modify the reference and there must be a reasonable

expectation of success. Applicant teaches a three part composition. In the instant case, Terranova **teaches all** of the claim limitations. He teaches compositions containing the claimed

1) pyrazolo[1,5-a]pyrimidines, see page 3, line 7-page 4, line 19; and page 4, line 26-page 5, line 30.

2) compositions containing additional oxidation bases including the claimed second oxidation base N,N-bis(β-hydroxyethyl)-p-phenylenediamine , see page 10 first full paragraph

3) preferred couplers including both m-aminophenols and m-phenylenediamines as claimed, see page 11, line 12-page 12. Since the reference teaches all of the claim limitations, there is no need for motivation to modify the reference, and applicant expects success using the composition as claimed because he teaches the inclusion of all of the elements as claimed. Applicant admits on pages 4 and 5 of the response that patentee's disclosure includes all of the compositional elements as claimed, and that it teaches using them in combination for the purpose of dyeing hair. Applicant states that Terranova does not teach any composition as claimed. This office respectfully disagrees. Though Terranova does not give a working example of the composition as claimed, he certainly teaches all of the elements, and that they are useful in combination to dye hair. See places cited above. All disclosures of the prior art, including non-preferred embodiment, must be considered. See *In re Lamberti and Konort,* 192 USPQ 278 (CCPA 1967); *In re Snow* 176 USPQ 328(CCPA 9173) All of the disclosures in a reference must be evaluated for what they fairly teach to one or ordinary skill in the art. *In re Smith*, 32 CCPA 959, 148 F.2d 351, 65 USPQ 167; *In re Nehrenberg*, CCPA 1159, 280 F. 2d 161, 126

USPQ 383. Note M.P.E P. 2123,"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain. *In re Heck*, 699 E.2d 1331, 1332-1333, 216 USPQ 1038, 1039 (Fed Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843(Fed. Cir.) *cert. denied*, 493 U. S. 975 (1989). **Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).**

Applicant states that there is no particular teaching or suggestion in Terranova that would motivate one to add a second oxidation base to the compositions of Terranova. That statement is not understood. There is no motivation needed since Terranova specifically teaches adding an additional oxidation base, and the one particularly claimed, at page 10 first full paragraph. Additionally it is notoriously well known to use combinations of oxidation bases in oxidative hair dyeing. It is prima facie obvious to combine two compositions each taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. See In re Kerkhoven,205 USPQ 1069,1072. For all of the above reasons, the rejection of record is maintained.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is (703) 308-3826. The examiner can normally be reached on Monday to Thursday and alternate Fridays from 7:00 A.M. to 4:30 P.M. The fax phone number for this Technology Center is (703) 305-3599

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Margaret Einsmann

MARGARET EINSMANN

PRIMARY EXAMINER 1751

July 11, 2001